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In re Application of
KENT, et al.
Application No.: 09/831,307
PCT No.: PCT/AU99/00989
Int. Filing Date: 09 November 1999
Priority Date: 09 November 1998
Attorney Docket No.: 229752001400
For: A VIPOX VECTOR CODING AN HIV
ANTIGEN AND A CYTOKINE

NOTIFICATION REGARDING
DEFECTIVE DECLARATION

AND

REQUIREMENT FOR NEW
DECLARATION OR REQUEST
UNDER 37 CFR 1.497(d)

This is to notify applicants that the declaration filed on 07 January 2002 in the above-captioned application is not in compliance with 37 CFR 1.497(a) and that a new declaration or submission under 37 CFR 1.497(d) is required.

BACKGROUND

On 09 November 1999, applicants filed the above-captioned international application, which claimed a priority date of 09 November 1998 and designated the United States. The international application named Stephen Kent and Ian Allister Ramshaw as applicants/inventors and David Bernard Boyle as an applicant only. A Demand for international preliminary examination was filed prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 09 November 2001.

On 08 May 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a basic national fee of \$860 and a PCT International Search Report.

On 15 June 2001, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b) and the surcharge 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 14 September 2001, applicants filed a declaration naming as inventors and signed by: Stephen Kent, Ian Allister Ramshaw and David Bernard Boyle. The response was accompanied by a petition for a one-month extension of time and thus timely filed.

On 06 December 2001, applicant was mailed a "Notification of Defective Response" (Form PCT/DO/EO/916) requiring an executed oath or declaration in compliance with 37 CFR 1.492(a) and (b), payment of the appropriate surcharge under 37 CFR 1.492(e), as well as, the filing of a sequence listing for the present application.

On 07 January 2002, applicant filed a declaration naming as inventors and signed by: Stephen Kent, Ian Allister Ramshaw and David Bernard Boyle and a sequence listing.

DISCUSSION

The declaration filed 07 January 2002 is not acceptable. Specifically, the declaration sets forth an additional inventor (David Bernard Boyle) who has not been named in the international application. Mr. Boyle was listed as an applicant only in the published international application. As such, the filed declaration is a defective response to the "Notification of Defective Response" mailed 06 December 2001 indicating that the declaration was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. However, since the "Notification of Defective Response" did not indicate the fact that the declaration was also defective since an additional inventor appeared on the declaration, applicant is hereby afforded **ONE (1) MONTH** to file one of the following responses:

Applicant must submit either: 1) a submission under 37 CFR 1.497(d) requesting correction of the inventors named in the international application to include David Bernard Boyle, (2) a new declaration naming and signed by only by Stephen Kent and Ian Allister Ramshaw accompanied by an acceptable explanation of the misnaming of the inventor on the present declaration, or (3) a showing that a change under PCT Rule 92bis was made prior to the National stage filing.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

CONCLUSION

A proper response, as discussed above, must be filed within **ONE (1) MONTH** of the date of mailing of this notification. No extensions of this time limit may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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